

AC 1616



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In re Application of:) Art Unit: 1616
JORGENSEN, Rolf Jess) Examiner: LEVY, N.
Serial No.: 09/527,680) Washington, D.C.
Filed: March 17, 2000) January 27, 2004
For: A METHOD OF PREVENTING) Docket No.: JORGENSEN=2
PARTURIENT HYPOCALCEMIA)
IN ANIMALS...) Confirmation No.: 2845

REQUEST TO WITHDRAW FINALITY

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S i r :

The finality of the rejection mailed December 8, 2003 should be withdrawn as it states a new ground of rejection (enablement), which was not necessitated by Applicant's last amendment.

This is the fifth action on the merits, and the enablement rejection could have been made in any one of the four prior rejections (6/28/01, 1/18/02, 10/23/02, 3/27/03).

The enablement rejection as stated is vague and generalized; it is certainly not responsive to the last amendment to main claim 14. That amendment merely added explicit recitation of "a zeolite" in view of the examiner's position that "a clay mineral" does not include a zeolite. It has been clear all along that Applicants were claiming use of a zeolite, see original claims 17-19. Indeed, the amendment was one which could reasonably be expected, in view of the 112/2 rejection of claim 18 and 19 and the species election of "zeolite".

While original claim 14 did not require encapsulation, original claim 15 did, and hence, if there was an enablement problem with encapsulation, it should have been raised in the first action, not the fifth.

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If the enablement issues was overlooked by the Examiner, he has a right to raise it belatedly now, but in turn he must give applicants a full opportunity to be heard, i.e., he cannot impose finality.

The imposition of finality is plainly improper under MPEP 706.07(a).

Respectfully submitted,

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